

REMARKS

Claims 20-69 are pending in this application, with claims 20, 24, 36, 38, 39, 49 and 69 being independent. Claims 24-37, 39-56, 58, 60 and 62-67 have been previously withdrawn; claim 38 has been amended to incorporate the features of its cancelled dependent claim 71; and claim 70 has been canceled without prejudice. No new matter has been added.

Applicant acknowledges with appreciation the Examiner's indication that claims 22 and 23 are directed to allowable subject matter.

Independent claim 20 and its dependent claims 21, 59 and 68 have been rejected as being anticipated by Kagawa (U.S. Patent No. 5,163,433). Independent claim 20 has also been rejected as being anticipated by Obenchain (U.S. Patent No. 5,195,541).

Independent claim 20 recites, among other features, "discharging substantially only fluid along a second path, said discharge along said second path being regulated to control pressure in said distensible organ" (emphasis added). Neither Kagawa nor Obenchain describes or suggests at least this feature.

While Kagawa describes introducing water into a body cavity via a water supply passage 25 that may be subsequently sucked out of the body cavity via a first suction passage 21 and via a second suction passage 26 (which the Examiner equates to the recited second path) (col. 7, lines 1 to 39), Kagawa does not describe or suggest that the discharge of water through the second suction passage 26 is regulated to control pressure in the body cavity. The Examiner, however, asserts that this limitation is met by Kagawa:

Further, to avoid over flow of the body cavity, the fluid supplied from passage 25 and fluid discharged through passages 21 and 26 must be regulated so as to keep a balance between the inflow fluid from passage 25 and outflow fluid through passages 25 and 26. Therefore, the pressure in the cavity body would be substantially constant. ...

KAGAWA device inherently discloses a method of discharging fluid with detached tissue through a first path (passage 21 as indicated above) and discharging substantially only fluid along a second path (passage 26 as indicated above) so as to regulate the pressure in the body cavity to remain substantially constant. Alternatively, to avoid over flow of fluid from the body cavity, it would have been obvious to one of ordinary skill in the art at the time of the invention to regulate the KAGAWA device a [sic] in a method as recited in the claims such that the inflow fluid from passage 25 and the discharge fluid through passages 25, 26 out of the body cavity are regulated to control a pressure in the body cavity under operation or keep the pressure inside the body cavity substantially constant to avoid a bursting of the cavity body.

See Final Office Action, pages 3 and 4. Accordingly, the Examiner is apparently contending that it is inherent in Kagawa to regulate the pressure in the body cavity to keep a balance between the inflow of water through passage 25 and the outflow of water through passages 21 and 26 such that the pressure remains substantially constant. The Examiner also asserts that even if such regulation were not inherent, it would be obvious to regulate the discharge through passage 26 to control the pressure to prevent “bursting” or “overflow” of the body cavity. Applicant respectfully disagrees.

There is no teaching or suggestion in Kagawa of regulating discharge along the suction passage 26 to control pressure in the body cavity. Furthermore, there is no basis for the Examiner's position that such regulation is inherent or obvious.

To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” (emphasis added) ... “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” In re Robertson, 169 F.3d 743 (Fed. Cir. 1999). Nothing in Kagawa states that there must be a balance between the inflow and outflow of water in the body cavity or a constant pressure in the body cavity, and even if desirable, as the Examiner contends, which applicant does not concede, that outflow through a path along which substantially only fluid is discharged need be regulated to obtain it. For example, it would appear just as likely that other outflow paths (e.g., outflow through passage 21) could be regulated or the inflow path (e.g., through passage 25) could be regulated to achieve the balance or the constant pressure. Accordingly, regulating discharge along the suction passage 26 to control pressure in the body cavity is not “necessarily present in the thing described in the reference” (emphasis added) and, therefore, is not inherent in Kagawa.

Furthermore, regulating the discharge along the suction passage 26 to control the pressure in the body cavity would not have been obvious to a person of ordinary skill in the art in view of the teachings of Kagawa, as suggested by the Examiner. As stated above, even if it were desirable in Kagawa to have a fluid balance in the body cavity or a constant pressure in the body cavity, such a fluid balance or constant pressure could apparently be achieved in multiple

different ways other than by regulating the discharge along the suction passage 26. Moreover, the Examiner's assertion that such regulation of fluid would be obvious to avoid "bursting" or "overflowing" of the body cavity is unfounded. For example, if the body cavity of Kagawa were within a distensible organ, which applicant does not concede, an imbalance between the inflow of water into the body cavity and the outflow of water from the body cavity need not "overflow" or "burst" the body cavity. Rather, the imbalance could simply result in an increase of pressure in the body cavity, causing the organ to distend. Accordingly, absent impermissible hindsight based on applicant's own disclosure, a person of ordinary skill in the art would not be motivated to modify Kagawa to regulate the discharge of water along the suction passage 26 to control the pressure in the body cavity.

Obenchain also does not describe or suggest a "discharging substantially only fluid along a second path, said discharge along said second path being regulated to control pressure in said distensible organ" (emphasis added). Obenchain describes introducing fluid into a body cavity and suctioning fluid out of a body cavity via irrigation and/or suction components 55, 57 and 59. See col. 4, lines 5-42. Obenchain, however, does not describe or suggest that the discharge of fluid through components 55, 57 and/or 59 is regulated to control pressure in the body cavity. Moreover, such a feature is not inherent or obvious in view of Obenchain's teachings for at least the same reasons discussed above with respect to Kagawa.

For at least these reasons, applicant requests reconsideration and withdrawal of the rejections of claim 20 and its dependent claims 21, 59, and 61.

Claim 21, which depends from claim 20, further recites the feature "in which the pressure in said distensible organ is substantially constant." Kagawa and Obenchain do not describe or suggest regulating a discharge of substantially only fluid to control pressure in a body cavity such that the pressure in the body cavity is substantially constant. As stated above, a mere description that fluid is input into a body cavity and sucked out of the body cavity does not inherently require a regulation of the inflow of fluid to control pressure in the body cavity, much less a regulation of the inflow fluid to maintain the pressure in the body cavity substantially constant. Rather, the pressure may vary due to fluid inflow/outflow imbalances without "bursting" or "overflowing" the body cavity. Therefore, for at least this additional reason, applicant requests reconsideration and withdrawal of the rejection of claim 21.

Independent claims 38 and 69, and dependent claim 61, which depends from claim 38, have been rejected as being anticipated by Obenchain. Independent claim 38, as amended, recites, among other features, “discharging substantially only fluid along a second path, ... wherein said discharge along said second path is regulated to control pressure in said body cavity” (emphasis added). Independent claim 69 recites, among other features, “discharging substantially only fluid along a second path, said discharge along said second path being regulated to control pressure in said body cavity” (emphasis added). For at least the reasons discussed above with respect to claim 20, applicant requests reconsideration and withdrawal of the rejection of claims 38, 69, and 61.

Claim 57, which depends from claim 20, has been rejected as being unpatentable over Obenchain in view of Grinberg (U.S. Patent No. 5,759,185). Claim 68, which also depends from claim 20, has been rejected as being unpatentable over Obenchain in view of Savage (U.S. Patent No. 6,113,594). Grinberg describes a powered arthroscopic surgical instrument for cutting tissue. Savage describes a method and system for electrosurgically treating tissue within the uterus and prostate. Neither Grinberg, Savage, nor any proper combination of the two remedies the failure of Obenchain to describe or suggest “discharging substantially only fluid along a second path, said discharge along said second path being regulated to control pressure in said distensible organ” (emphasis added). Accordingly, for at least the reasons discussed above, applicant requests reconsideration and withdrawal of the rejection of claims 57 and 68.

Applicant does not acquiesce in the Examiner's characterizations of the art. For brevity and to advance prosecution, however, applicant may have not addressed all characterizations of the art and reserve the right to do so in further prosecution of this or a subsequent application. The absence of an explicit response by the applicants to any of the Examiner's positions does not constitute a concession of the Examiner's positions. The fact that applicant's comments have focused on particular arguments does not constitute a concession that there are not other arguments for patentability of the claims. All of the dependent claims are patentable for at least the reasons given with respect to the claims on which they depend.

Applicant submits that all claims are in condition for allowance.

Applicant : Mark Hans Emanuel
Serial No. : 09/486,977
Filed : March 6, 2000
Page : 13 of 13

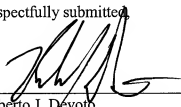
Attorney's Docket No.: 00167-404001 / 02-31-0340

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: _____

9/15/06



Roberto J. Devoto
Reg. No. 55,108

Fish & Richardson P.C.
Citigroup Center
52nd Floor
153 East 53rd Street
New York, New York 10022-4611
Telephone: (212) 765-5070
Facsimile: (212) 258-2291

30291046.doc